

Appl. No 10/710,010
Amdt. Dated November 8, 2005
Reply to office action of October 31, 2005

RECEIVED
CENTRAL FAX CENTER

NOV 08 2005

REMARKS/ARGUMENTS

The Office Action states in item 2 that "Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Umfleet (5,989,012), which shows all of the claimed limitations." Applicant respectfully traverses this rejection.

The MPEP section 2130 contains a footnote, which includes "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Applicant, in review of Umfleet (5,989,012), fails to find all elements of applicant's method Claim 9. Among the elements not found in Umfleet (5,989,012) is the element of applicant's Claim 9 item d., moving the candlewick fixing device in a desired horizontal direction wherein the candlewick is repositioned in the desired direction. Applicant has amended Claim 9, not to add additional limitations, but to state the multiplicity of horizontal directions possible with applicant's invention in the same language used in applicant's specification paragraph [0044]. Umfleet (5,989,012) requires either pushing or pulling the Umfleet (5,989,012) invention to reposition the candlewick to extinguish the flame due to the inherent structure of that invention (See Umfleet (5,989,012) Col. 1 lines 40-45 and Umfleet Claims 1 and 2). Applicant further notes in Umfleet (5,989,012) figure 4 a twisting motion, not a horizontal motion, is required by the Umfleet (5,989,012) invention structure to restore the candlewick to an upright position.

Claim 9 therefore has been shown to have limitations not anticipated by Umfleet (5,989,012) and is therefore an allowable claim and the rejection is respectfully requested to be removed.

The Office Action further states in item 5: "Claims 1-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nunemaker (3,985,492)...." Regarding Claims 1-5 Applicant respectfully traverses this rejection. The applicant recites below four grounds that show Nunemaker (3,985,492) fails to support a prima facie case of obviousness for Claims 1-5 and 8.

First, applicant respectfully traverses the use of Nunemaker as a reference under 35 U.S.C. 103(a). In order to use a reference under 35 U.S.C. 103(a) it must be determined what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue.

Appl. No 10/710,010
Amdt. Dated November 8, 2005
Reply to office action of October 31, 2005

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. While Patent Office classification of references and the cross-references in the official search notes are some evidence of "nonanalogy" or "analogy" respectively, the MPEP guidance provides that "the similarities and differences in structure and function of the inventions carry far greater weight." Nunemaker (3,985,492) shows a combination candle lighter and extinguisher. There is no suggestion, discussion, or showing of a candlewick straightening device in Nunemaker (3,985,492). Thus the Nunemaker (3,985,492) reference is non-analogous prior art for purposes of a reference under 35 U.S.C. 103(a).

Second, applicant respectfully notes a patent rejection under 35 U.S. C. 103(a) bears the initial burden of factually supporting any prima facie conclusion of obviousness. This initial burden includes providing some suggestion of the desirability of doing what the inventor has done in the prior art reference. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. There is no suggestion, motivation, or expectation of success in Nunemaker (3,985,492) to straighten a candlewick and therefore Nunemaker (3,985,492) does not support a rejection under 35 U.S. C. 103(a).

Third, applicant respectfully fails to find all elements of applicant's Claims 1-5 limitations in Nunemaker (3,985,492). There is no suggestions, discussion, or showing, for example, of applicant's Claim 1 limitation of "a candlewick hook with a straight portion end and a bent portion end, the straight portion end attached to the handle second end, the hook bend portion end positioned adjoining the bend forming a single circular opening..." in Nunemaker (3,985,492). There is no suggestion, discussion, or showing of a hook bent into a single circular opening in Nunemaker (3,985,492). Instead Nunemaker (3,985,492) shows a match holder with

Appl. No 10/710,010
Amdt. Dated November 8, 2005
Reply to office action of October 31, 2005

the structure of a 2-3 mm coil (Nunemaker figure 1 and Col. 3 line 6-7) or a solid piece of metal with a 2-3 mm opening (Nunemaker figures 2 and 3 and Col. 3 lines 26-27 and 48-49).

Fourth, applicant respectfully submits that Nunemaker (3,985,492) teaches away from the applicant's invention in teaching the size of the opening of 2-3 mm must snugly hold a safety match (Col. 2, lines 8 and 14). The modification proposed in the rejection would render the Nunemaker (3,985,492) invention unsatisfactory for its intended purpose and thus Nunemaker (3,985,492) cannot serve as a predicate for a prima facie case of obviousness per *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), *In re Spinnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244, 56 C.C.P.A. 823 (1969), and MPEP 2143.01.

Regarding the rejection of Claim 8 under 35 U.S.C. 103(a) as being unpatentable over Nunemaker (3,985,492), Claim 8 is a means plus function claim meeting the criteria of 35 U.S.C. 112, and directed to a candlewick-straightening device and flame snuffer. It therefore includes all limitations of applicant's invention and equivalents in the specification. Applicant has previously shown that the Nunemaker (3,985,492) patent does not teach all limitations of applicant's invention. There are also further claim limitations of Claim 8, not addressed in Nunemaker (3,985,492), included in applicant's specification, for example, the bend angle in paragraph [0036] and the candlewick hook angle in paragraph [0037] that are not addressed in the rejection. In addition, as indicated previous, the four grounds that show Nunemaker (3,985,492) fails to support a prima facie case of obviousness apply to Claim 8.

Nunemaker (3,985,492) has been shown to not support a prima facie case of obviousness of Claims 1-5 and 8. These claims therefore are allowable claims and the rejection under 35 U.S.C. 103(a) as being unpatentable over Nunemaker (3,985,492) is therefore respectfully requested to be removed.

The Office Action further states in item 6, "Claims 6 and 7 are rejected under 35 U.S. C. 103(a) as being unpatentable over Nunemaker (3,985,492) in view of Schroeder (1,572,316)." Applicant respectfully traverses the rejection of Claims 6 and 7 under 35 U.S. C. 103(a) as being unpatentable over Nunemaker (3,985,492) in view of Schroeder (1,572,316).

Applicant respectfully notes that, as shown previously, the Nunemaker (3,985,492) patent is non-analogous prior art that fails to support a prima facie case of obviousness for Claims 1-5. Since Claims 6 and 7 are dependant claims on now allowable Claim 5, the combination of

Appl. No 10/710,010
Amdt. Dated November 8, 2005
Reply to office action of October 31, 2005

Nunemaker (3,985,492) and Schroeder (1,572,316) also fails to support a prima facie case of obviousness for Claims 6 and 7.

Claims 1 and 9 have been amended to correct matters of form. Claim 9 has also been amended to remove a limitation unnecessary to applicant's patent rights.

Applicant submits that all objections and rejections of claims have been addressed and applicant's application has been shown to be allowable and that action is respectfully requested.

Respectfully submitted:



William Keyworth
Reg. No. 47704
(415) 397-8056